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DATE: July 8, 2005 ATTORNEY DOCKET NUMBER: BSS 6426.1  
PTO FACSIMILE NUMBER: (703) 872-9306

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Type of paper transmitted: Notice of Appeal from the Primary  
Examiner to the Board of Patent Appeals and Interferences and  
Pre-Appeal Brief Request for Review

Applicant's Name: Jeffrey S. Brooks

Serial No. (Control No.): 10/685,059 Examiner: T. Courson

Filing Date: 10/14/03 Art Unit: 2859 Confirmation No.: 5710

Application Title: FOOT SCANNING AND MEASUREMENT SYSTEM AND METHOD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Jeffrey S. Brooks  
Serial No. 10/685,059  
Filed October 14, 2003  
Confirmation No. 5710  
For FOOT SCANNING AND MEASUREMENT SYSTEM AND METHOD  
Examiner Tania C. Courson

July 8, 2005

**NOTICE OF APPEAL FROM THE PRIMARY EXAMINER  
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

COMMISSIONER FOR PATENTS,  
P.O. BOX 1450  
ALEXANDRIA, VIRGINIA 22313-1450

SIR:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the Examiner dated April 12, 2005, finally rejecting claims 1-22.

The Commissioner is authorized to charge the appeal fee of \$250 to our Deposit Account No. 19-1345. If there are any additional charges in this matter, please charge our Deposit Account No. 19-1345.

Respectfully submitted,

Michael E. Golan

Michael E. Godar, Reg. No. 28,416  
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Via Facsimile 703-872-9306  
Mail Stop AF / Examiner Courson

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Application of Jeffrey S. Brooks  
Serial No. 10/685,059  
Filed October 14, 2003  
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For FOOT SCANNING AND MEASUREMENT SYSTEM AND METHOD  
Examiner Tania C. Courson

July 8, 2005

PRE-APPEAL BRIEF REQUEST FOR REVIEW

TO THE COMMISSIONER FOR PATENTS,

SIR:

Applicant hereby requests review of the Office's rejection of claims 1-22 as set forth in the final Office action dated April 12, 2005 and Interview Summary dated June 22, 2005. A Notice of Appeal is being filed concurrently herewith.

While no fees are believed due with respect to this Request, the Commissioner is authorized to charge any fees due to Deposit Account No. 19-1345.

## ARGUMENTS

Claim 1 stands rejected under 35 U.S.C. § 103 as being obvious in view of U.S. Patent Nos. 2,399,424 (Bliss) and 5,025,476 (Gould et al.). Claim 1 is directed to a system for measuring the size of a foot comprising a) a support surface having an opening therein, b) a fixture positioned over the opening having a cavity suitable for receiving a foot to be measured, and c) an imaging device positioned relative to said opening to produce an image of a bottom surface of the foot superimposed on foot measuring indicia visually indicative of foot size. Claims 2-22 also include the requirement of an image of the foot superimposed on foot measuring indicia visually

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indicative of foot size and were rejected for the same reason as claim 1.

Applicant submits that the Examiner's rejection is clearly erroneous. In particular, Applicant disagrees on the ground that one of ordinary skill would not be motivated to modify Gould et al. in light of Bliss. For the reasons stated below, Applicant respectfully submits that the pending claims in their current form are patentable over the prior art of record, including Gould et al. and Bliss.

Gould et al. describes an apparatus comprising a light source (28), grating (41), camera (46), and computer (not shown). The light from the light source passes through the grating at an angle and strikes the foot, producing shadow lines on the bottom of the foot. (Col. 4, line 48). The camera is positioned to view the foot through the grating. Because the light source strikes the grating at a first direction (38), which is different from the direction (48) at which the camera views the foot, the shadow lines interfere with the straight lines of the grating to produce a fringe pattern, as shown in Fig. 5 and described in col. 5, lines 31-35. A snapshot image from the camera (showing the fringe pattern) is downloaded on the computer in digital form. (Col. 6, lines 10-19.) The computer analyzes the image (using the pixels of the digital image) to extract information about the foot to develop an entire topography of the foot for use in designing an orthotic. (Col. 11, lines 62-68; col. 2, lines 4-7.)

As recognized by the examiner, Gould et al. fails to disclose an image of the foot superimposed on foot measuring indicia visually indicative of foot size. All claims of this application include this requirement.

Bliss describes an apparatus comprising an X-ray cassette (27) or screen (36) for fluoroscopy laid on a solid platform (15). The cassette and screen have scales for showing foot size.

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In use, the cassette (27) or screen (36) is either placed on the platform (15) or underneath the platform, and X-rays are passed down through the feet of a person to produce an image of the foot (i.e., outline of feet and bone structure). There is no opening in the platform (15), and the device does not produce an image of the bottom surface of the foot. Instead, what is produced is an outline of the feet and of bone structure, superimposed on the scale. (Col. 1, lines 41-45).

It is the examiner's position that it would be obvious in view of Bliss to modify the apparatus in Gould et al. to include a scale (presumably on the grating), and that such a scale would provide foot measuring indicia superimposed on the bottom of the foot visually indicative of foot size. Applicant respectfully disagrees on the ground that one of ordinary skill would not be motivated to make such a modification.

Before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996). Such suggestions may come: (1) expressly from the references themselves, (2) from knowledge of those skilled in the art that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field, and (3) from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem. Id.

Here, the references do not expressly make any suggestion of combination together. There is no reason to believe the Gould et al. and Bliss references are known to be of special interest in the particular field. The nature of the problem to be solved, a method for measuring foot size, also does not suggest combination of the references because Gould et al. includes a method for

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measuring foot size using computer analysis thus making the scale disclosed in Bliss unnecessary.

The apparatus in Gould et al. uses shadow lines, cameras and computer analysis to measure various foot size characteristics. One skilled in the art would not be motivated to use a scale in the Gould et al. device because any such scale would have no purpose in the device. The computer does not need such a scale to measure foot size. Instead, the computer measures foot size, among many other characteristics, by digital analysis of the downloaded camera image of the foot. A visual scale for the purpose of determining foot length would be entirely superfluous. Further, as previously noted, Gould et al. uses a computer to determine the entire topography of a foot, including height and shape information. A scale visually indicative of foot size would not satisfy this need, further reinforcing the notion that any such scale would have no value in Gould et al.

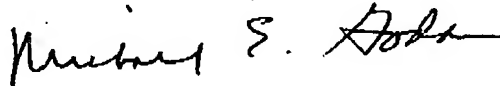
For all of the above reasons, claim 1 is submitted as patentable over the references of record, including Gould et al. and Bliss, because one skilled in the art would not be motivated to make the modification of Gould et al. in light of Bliss. One skilled in the art would not be motivated to make the modification because Gould et al. uses computer analysis to measure foot size, thus making a visual scale unnecessary.

Claims 2-22, which were rejected for the same reason as claim 1, are submitted to be patentable over the references of record for at least the same reasons as claim 1.

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In view of the foregoing, favorable consideration and allowance of claims 1-22 is respectfully requested.

Respectfully submitted,



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